

Response to Office Action
Mailed February 18, 2003
For Serial No. 09/853,276

REMARKS

In the Office Action, the Examiner rejected claims 1-3, 5-7, and 10-15, and withdrew claims 4, 8, and 9 from consideration. As discussed below, the Applicant respectfully stresses that the pending claims recite a variety of features absolutely devoid from the cited references. In view of these deficiencies, Applicant respectfully requests reconsideration and allowance of all pending claims. Applicant also emphasizes the lack of a substantive rejection of claim 11. The Examiner has not provided any grounds for rejecting claim 11 and, therefore, claim 11 is believed to be in condition for allowance. The Applicant also reminds the Examiner that a Final Office Action would be improper in view of the omitted grounds of rejection for claim 11. See M.P.E.P. § 706.07

Claim Rejections – 35 U.S.C. § 102

The Examiner rejected claims 1, 2, 5, and 15 under U.S.C. § 102(e) as anticipated by Hatanaka et al., U.S. Patent No. 6,130,735. Applicant respectfully traverses these rejections.

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, the Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “in as complete detail as contained in the ... claim” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

As discussed below, the claimed technique *does* have patentably distinct elements not found in the references cited by the Examiner. For example, amended claim 1 recites:

Response to Office Action
Mailed February 18, 2003
For Serial No. 09/853,276

a display screen,
a *transparent panel* having a backside and an *anti-glare front surface* configured to diffuse ambient light; and
a *bulk diffuser disposed between the display screen and the backside*, wherein the bulk diffuser is *bonded* to at least one of the display screen and the transparent panel, and the bulk diffuser is configured to diffuse image light of the display.

(Emphasis Added). In contrast, the Hatanaka et al. reference teaches a liquid crystal cell 13, a scattering film layer 10 disposed in front of the liquid crystal cell 13, a retardation film layer 12 disposed in front of the scattering film layer 10, and a polarizer 11 disposed in front of the retardation film layer 12. See Hatanaka et al., Col. 7, lines 42-48. In the Office Action, the Examiner correlated the liquid crystal cell 13, the scattering film layer 10, and the polarizer 11 of Hatanaka et al. to the presently claimed display screen, bulk diffuser, and transparent panel, respectively. See Paper No. 7, Page 4. However, the Examiner incorrectly interpreted the cited reference's disclosure of the polarizer 11 as a transparent panel. Instead, the Hatanaka et al. reference teaches the polarizer 11 as a "neutral gray polarizer" functioning to absorb light at an "absorption axis" of 45 degrees. Hatanaka et al., Col. 8, lines 2-6. As explicitly disclosed by Hatanaka et al., the polarizer 11 is neither transparent in color nor transparent to light transmission. See *id.* Accordingly, the cited reference is missing at least one element, i.e., the transparent panel, which precludes a *prima facie* case of anticipation as set forth above.

Given the lack of an explicit disclosure of a transparent panel, if the Examiner relies on a theory of inherency, then the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999) (Emphasis Added). The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Id.* In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in

Response to Office Action
Mailed February 18, 2003
For Serial No. 09/853,276

original). The Examiner, in presenting the inherency argument, bears the evidentiary burden and must adequately satisfy this burden. *See id.* Regarding functional limitations, the Examiner must evaluate and consider the functional limitation, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. *See* M.P.E.P. § 2173.05(g); *In re Swinehart*, 169 U.S.P.Q. 226, 229 (CCPA 1971); *In re Schreiber*, 44 U.S.P.Q.2d 1429, 1432 (Fed. Cir. 1997). If the Examiner believes the functional limitation to be inherent in the cited reference, then the Examiner "must provide some evidence or scientific reasoning to establish the reasonableness of the examiner's belief that the functional limitation is an inherent characteristic of the prior art." *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Inter. 1986).

The Examiner does not suggest, nor does the cited reference support, a conclusion that the polarizer 11 is "a transparent panel having a backside and an anti-glare front surface configured to diffuse ambient light," as recited by claim 1. The disposition and function of the polarizer 11 in the cited reference does not support the conclusion that the polarizer 11 would necessarily be transparent. As stated above, the mere possibility that the polarizer 11 may be transparent in the cited art is not sufficient to support the conclusion that the feature is "inherent." As discussed above, the cited reference explicitly discloses the polarizer 11 as a "neutral gray polarizer" functioning to absorb light at an "absorption axis" of 45 degrees. Hatanaka et al., Col. 8, lines 2-6. One of ordinary skill in the art would simply have no reason or motivation to modify the polarizer 11 to be transparent in view of the explicit teachings of Hatanaka et al.

In view of this omitted claim recitation, i.e., transparent panel, independent claim 1 and its respective dependent claims are believed to be patentable over the Hatanaka et al. reference. Accordingly, Applicant respectfully requests the Examiner withdraw the rejection of claims 1, 2, 5, and 15 under 35 U.S.C. § 102(e).

Response to Office Action
Mailed February 18, 2003
For Serial No. 09/853,276

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 3, 6, and 10 under 35 U.S.C. §103(a) as unpatentable over Hatanaka et al. in view of Morgan et al., U.S. Patent No. 6,068,227. The Examiner also rejected claim 7 under 35 U.S.C. §103(a) as unpatentable over Hatanaka et al. and Morgan et al. in view of Varaprasad et al., U.S. Patent No. 6,087,012. Finally, the Examiner rejected claims 12, 13, and 14 under 35 U.S.C. §103(a) as unpatentable over Hatanaka et al. in view of Sanelle et al., U.S. Patent No. 6,181,394.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Applicant respectfully traverses the foregoing rejections for a number of reasons. First, all of the claims subject to this rejection under 35 U.S.C. § 103 are dependent on independent claim 1, which is believed to be patentable over the Hatanaka et al. reference for the reasons set

Response to Office Action
Mailed February 18, 2003
For Serial No. 09/853,276

forth above. Second, the remaining references do not obviate the deficiencies of the primary reference. Third, the Examiner has not provided *objective evidence* of the requisite suggestion or motivation to modify or combine the references.

Dependent Claims 3, 6, and 10:

Claims 3 and 6 both depend from independent claim 1, while claim 10 depends from claim 6. The Morgan et al. reference does not obviate any of the deficiencies of the primary reference, i.e., Hatanaka et al., as discussed in detail above. Independent claim 1 recites, *inter alia*, "a transparent panel having a backside and an anti-glare front surface configured to diffuse ambient light." As discussed above, the Hatanaka et al. reference contrastingly discloses the polarizer 11 as a "neutral gray polarizer" functioning to absorb light at an "absorption axis" of 45 degrees. Hatanaka et al., Col. 8, lines 2-6. Accordingly, the polarizer 11 is neither transparent in color nor transparent to light transmission.

Although the Morgan et al. reference discloses a glass panel 40 having an anti-reflective coating and an anti-glare treatment etched on a front surface 42, the Examiner has not shown the requisite motivation or suggestion to modify or combine the Hatanaka et al. and Morgan et al. references to reach the presently claimed technique. Neither the primary reference nor any of the other cited references provide any teaching, suggestion, or motivation to modify the polarizer 11 of the primary reference to provide a "transparent panel," as recited in claim 1. Moreover, there is no motivation or suggestion to combine the etched anti-glare treatment of Morgan et al. with the polarizer 11 of Hatanaka et al.

The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). In the present rejection, the Examiner combined the Hatanaka et al. and Morgan et al. references based on the *conclusory and subjective statement* that "Morgan is evidence that ordinary workers in the art of liquid crystals would find the reason, suggestion, or motivation to use an etched glass transparent panel as

Response to Office Action
Mailed February 18, 2003
For Serial No. 09/853,276

having art recognized suitability for the intended purpose of achieving desired anti-glare performance (MPEP 2144.07)." Paper No. 7, Page, No. 5. However, the Examiner has ignored the Hatanaka et al. reference's explicit disclosure of the polarizer as a *non-transparent* material. Hatanaka et al., Col. 8, lines 2-6. Accordingly, Applicant challenges the Examiner to produce objective evidence supporting the Examiner's alleged motivation to combine the cited references.

Even if objective evidence is identified to support the Examiner's alleged reason to combine the references, the Applicant submits that one of ordinary skill in the art would not be motivated to combine the Hatanaka et al. and Morgan et al. references. The Examiner's alleged reason to combine the references provides nothing more than the function of anti-reflective and anti-glare layers. There is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention. *Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 U.S.P.Q.2d 1415, 1420-21 (Fed. Cir. 1999). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Moreover, a statement that the proposed modification would have been "well within the ordinary skill of the art" based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levensgood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

Again, the Applicant challenges the Examiner to provide *objective evidence* of the requisite suggestion or motivation to combine or modify the references, rather than a mere statement of functionality.

The Examiner clearly *speculated* about the possibility of combining the reference without providing any objective evidence. In the process, the Examiner ignored the disclosure of Hatanaka et al., which clearly teaches away from a combination with the Morgan et al. reference.

Response to Office Action
Mailed February 18, 2003
For Serial No. 09/853,276

It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983). As mentioned above, the polarizer 11 is neither color transparent nor functionless regarding light transmission. Hatanaka et al., Col. 8, lines 2-6. Instead, the polarizer 11 specifically absorbs light in certain angles, i.e., an absorption axis of 45 degrees. *See id.* If the polarizer 11 were a mere transparent glass, as taught by Morgan et al., then the polarizer 11 would be rendered inoperable for its intended purpose. *See* M.P.E.P. § 2145. Therefore, the Hatanaka et al. – Morgan et al. combination is improper. *See id.* In addition, the Hatanaka et al. reference specifically teaches away from *undulated* surfaces, such as disclosed by Morgan et al. In the background of the invention section, the Hatanaka et al. reference discloses:

However, if provided with scattering characteristics by *undulations* as in the prior art II, *back scattering occurs* at the time of incidence of surrounding light into the liquid crystal display device. As a result, the reflectivity in black display is not lowered sufficiently, and high contrast is not obtained.

Hatanaka et al., Col. 1, lines 48-53 (emphasis added). In the summary section, the Hatanaka et al. reference lists several *objects of the invention*, including the substantial *elimination of back scattering* characteristics. Hatanaka et al., Col. 2, lines 15-20. Accordingly, the Hatanaka et al. reference clearly teaches away from the *etched* glass transparent panel of Morgan et al. In light of these passages, one of ordinary skill in the art would be discouraged from using a transparent panel having an etched anti-glare treatment with the display of Hatanaka et al. Accordingly, the Applicant respectfully maintains that the cited references do not teach or suggest, alone or in combination, the presently claimed technique.

In view of the foregoing, independent claim 1 and its respective dependent claims are believed to be patentable over the Hatanaka et al. and Morgan et al. references. Accordingly, Applicant respectfully requests the Examiner withdraw the rejection of claims 3, 6, and 10 under 35 U.S.C. § 103.

Response to Office Action
Mailed February 18, 2003
For Serial No. 09/853,276

Dependent Claims 7:

Claim 7 depends from claim 6, which depends from claim 1. The Varaprasad reference does not obviate any of the deficiencies of the primary or secondary references, i.e., Hatanaka et al. and Morgan et al. Independent claim 1 recites, *inter alia*, "a transparent panel having a backside and an anti-glare front surface configured to diffuse ambient light." As discussed above, the Hatanaka et al. reference contrastingly discloses the polarizer 11 as a "neutral gray polarizer" functioning to absorb light at an "absorption axis" of 45 degrees. Hatanaka et al., Col. 8, lines 2-6. Accordingly, the polarizer 11 of Hatanaka et al. is neither transparent in color nor transparent to light transmission.

As discussed above, the combination of Hatanaka et al. and Morgan et al. is believed to be improper. Similarly, the Applicant believes the combination of Hatanaka et al. and Varaprasad to be improper. Here again, the Examiner has not shown the requisite motivation or suggestion to modify or combine the Hatanaka et al., Morgan et al., and Varaprasad references to reach the presently claimed technique. Neither the primary reference nor any of the other cited references provide any teaching, suggestion, or motivation to modify the polarizer 11 of the primary reference to provide a "transparent panel," as recited in claim 1. Moreover, there is no motivation or suggestion to combine the etched anti-glare treatment of Morgan et al. with the polarizer 11 of Hatanaka et al. Finally, there is no motivation or suggestion to combine the etched anti-glare treatment of Morgan et al. with the polarizer 11 of Hatanaka et al. and the chemical etching of Varaprasad.

The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). In the present rejection, the Examiner combined the Hatanaka et al., Morgan et al., and Varaprasad references based on the *conclusory and subjective statement* that "Varaprasad is evidence that ordinary workers in the art of liquid crystals would find the reason, suggestion, or motivation to use a chemically etched

Response to Office Action
Mailed February 18, 2003
For Serial No. 09/853,276

glass transparent panel as having art recognized suitability for the intended purpose of achieving desired anti-glare performance (MPEP 2144.07)." Paper No. 7, Page, No. 6. However, the Examiner has ignored the Hatanaka et al. reference's explicit disclosure of the polarizer as a *non-transparent* material. Hatanaka et al., Col. 8, lines 2-6. As discussed in further detail below, the Examiner has also ignored the Hatanaka et al. reference's explicit teaching away from the use of *undulated* surfaces, such as the etched anti-glare treatments disclosed by Morgan et al. and Varaprasad. Accordingly, the proposed combination is believed to be improper and Applicant challenges the Examiner to produce objective evidence supporting the Examiner's alleged motivation to combine the cited references.

Even if objective evidence is identified to support the Examiner's alleged reason to combine the references, the Applicant submits that one of ordinary skill in the art would not be motivated to combine the Hatanaka et al., Morgan et al., and Varaprasad references. The Examiner's alleged reason to combine the references provides nothing more than the function of anti-reflective layers, anti-glare layers, and specifically etched anti-glare layers. There is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention. *Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 U.S.P.Q.2d. 1415, 1420-21 (Fed. Cir. 1999). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Moreover, a statement that the proposed modification would have been "well within the ordinary skill of the art" based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999). Again, the Applicant challenges the Examiner to provide *objective evidence* of the requisite suggestion or motivation to combine or modify the references, rather than a mere statement of functionality.

Response to Office Action
Mailed February 18, 2003
For Serial No. 09/853,276

Here again, the Examiner clearly *speculated* about the possibility of combining the reference without providing any objective evidence. In the process, the Examiner ignored the disclosure of Hatanaka et al., which clearly *teaches away* from a combination with the Morgan et al. and Varaprasad references. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983). As mentioned above, the polarizer 11 of Hatanaka et al. is neither color transparent nor functionless regarding light transmission. Hatanaka et al., Col. 8, lines 2-6. Instead, the polarizer 11 specifically absorbs light in certain angles, i.e., an absorption axis of 45 degrees. *See id.* If the polarizer 11 of Hatanaka et al. were a mere transparent glass, as taught by Morgan et al., then the polarizer 11 would be rendered inoperable for its intended purpose. *See* M.P.E.P. § 2145. Therefore, the Hatanaka et al. – Morgan et al. combination is improper. *See id.* In addition, the Hatanaka et al. reference specifically teaches away from undulated surfaces, such as disclosed by Morgan et al. and Varaprasad. In the background of the invention section, the Hatanaka et al. reference discloses:

However, if provided with scattering characteristics by *undulations* as in the prior art II, *back scattering occurs* at the time of incidence of surrounding light into the liquid crystal display device. As a result, the reflectivity in black display is not lowered sufficiently, and high contrast is not obtained.

Hatanaka et al., Col. 1, lines 48-53 (emphasis added). In the summary section, the Hatanaka et al. reference lists several *objects of the invention*, including the substantial *elimination of back scattering* characteristics. Hatanaka et al., Col. 2, lines 15-20. Accordingly, the Hatanaka et al. reference clearly teaches away from the *etched* glass transparent panel of Morgan et al. and the chemical etching of Varaprasad. In light of these passages, one of ordinary skill in the art would be discouraged from using a transparent panel having an etched anti-glare treatment with the display of Hatanaka et al. Accordingly, the Applicant respectfully maintains that the cited references do not teach or suggest, alone or in combination, the presently claimed technique.

Response to Office Action
Mailed February 18, 2003
For Serial No. 09/853,276

In view of the foregoing, independent claim 1 and its respective dependent claims are believed to be patentable over the Hatanaka et al., Morgan et al., and Varaprasad references. Accordingly, Applicant respectfully requests the Examiner withdraw the rejection of claim 7 under 35 U.S.C. § 103.

Dependent Claims 12, 13, and 14:

Claim 12 depends from claim 1, while claims 13 and 14 depend from claim 12. The Sanelle et al. reference does not obviate any of the deficiencies of the primary reference, i.e., Hatanaka et al. Independent claim 1 recites, *inter alia*, "a transparent panel having a backside and an anti-glare front surface configured to diffuse ambient light." As discussed above, the Hatanaka et al. reference explicitly discloses the polarizer 11 as a "neutral gray polarizer" functioning to absorb light at an "absorption axis" of 45 degrees. Hatanaka et al., Col. 8, lines 2-6. Accordingly, the polarizer 11 is neither transparent in color nor transparent to light transmission.

For reasons similar to those described above with reference to Hatanaka et al., Morgan et al., and Varaprasad, the Applicant believes the combination of Hatanaka et al. and Sanelle et al. to be improper. Here again, the Examiner has not shown the requisite motivation or suggestion to modify or combine the Hatanaka et al. and Sanelle et al. references to reach the presently claimed technique. Neither the primary reference nor any of the other cited references provide any teaching, suggestion, or motivation to modify the polarizer 11 of the primary reference to provide a "transparent panel," as recited in claim 1. Moreover, there is no motivation or suggestion to combine the index-matched material of Sanelle et al. with the display of Hatanaka et al.

The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). In the present rejection, the Examiner combined the Hatanaka et al. and Sanelle et al. references based on the *conclusory and subjective statement* that "Sanelle is evidence that ordinary workers in the art of liquid crystals

Response to Office Action
Mailed February 18, 2003
For Serial No. 09/853,276

would find the reason, suggestion, or motivation to add an index-matched bond material wherein the index-matched bond material is bubble-free, and wherein the index-matched bond material comprises an epoxy, to eliminate unwanted refractions and thereby improve display performance." Paper No. 7, Page, No. 7. In view of this conclusory statement, Applicant challenges the Examiner to produce *objective evidence* supporting the Examiner's alleged reason or motivation to combine the cited references.

Even if objective evidence is identified to support the Examiner's alleged reason to combine the references, the Applicant submits that one of ordinary skill in the art would not be motivated to combine the Hatanaka et al. and Sanelle et al. references. The Examiner's alleged reason to combine the references provides nothing more than the function of index-matched bond materials. There is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention. *Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 U.S.P.Q.2d 1415, 1420-21 (Fed. Cir. 1999). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Moreover, a statement that the proposed modification would have been "well within the ordinary skill of the art" based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999). Again, the Applicant challenges the Examiner to provide *objective evidence* of the requisite suggestion or motivation to combine or modify the references, rather than a mere statement of functionality.

In view of the foregoing, independent claim 1 and its respective dependent claims are believed to be patentable over the Hatanaka et al. and Sanelle et al. references. Accordingly,

Response to Office Action
Mailed February 18, 2003
For Serial No. 09/853,276

Applicant respectfully requests the Examiner withdraw the rejection of claims 12, 13, and 14 under 35 U.S.C. § 103.

Conclusion

In view of the foregoing remarks, Applicant respectfully submits that all pending claims should be in condition for allowance. Accordingly, Applicant requests the Examiner withdraw the outstanding rejections. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Date: May 19, 2003

Respectfully submitted,



Tait R. Swanson
Reg. No. 48,226
Fletcher, Yoder & Van Someren
P.O. Box 692289
Houston, TX 77269-2289
(281) 970-4545

FAX RECEIVED

MAY 19 2003

TECHNOLOGY CENTER 2800